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A-69056-1/ENB

CERTIFICATE UNDER 37 CFR 1.10

EXPRESS MAIL LABEL: EL 527 872 668 US

DEPOSITED: June 27 2001

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service in an envelope as "Express Mail" addressed to the Box Patent Application Fee; Assistant Commissioner for Patents, Washington, DC 20231.

Signed:

Raquel Graeber

Laura Lee Moser

Jc821 U.S. PTO
09/895609

10/29/01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

SHARKEY et al.Examiner: **To be assigned**Serial No.: **To be assigned**Group Art Unit: **To be assigned**Filing Date: **June 29, 2001**

For: **Surgical Instrument Having Distal
Face with First and Second
Electrodes**

NEW APPLICATION TRANSMITTAL**(37 C.F.R. § 1.53(b)(1))****Box PATENT APPLICATION FEE**

Assistant Commissioner for Patents

Washington, DC 20231

Sir:

1. **This new application is for an**☒ [xx] Original (non-provisional)☐ [] Design☐ [] Plant☐ [] divisional☒ [X] continuation☐ [] continuation-in-part (C-I-P)application under 37 C.F.R. 1.53(b), in the name of **Hugh R. SHARKEY,****Bruno STRUL, Daren L. STEWART, John ASHLEY, and Ramiro L. REYES**

for: **SURGICAL INSTRUMENT HAVING DISTAL FACE
WITH FIRST AND SECOND ELECTRODES**

This continuation application claims priority to pending application(s) Serial No(s).
09/412,878; filed October 5, 1999.

2. **Benefit of Prior U.S. Application(s)** (35 U.S.C. 119(e), 120, or 121)
- ☒ Enclosed is a copy of the prior application as originally filed.
- ☒ Priority application claims priority to pending application(s) Serial No(s).
09/412,878; filed October 5, 1999.
- ☐ the certified copy has been filed in prior application, Serial No. 0 / _____, filed
on _____.

3. **Papers enclosed:**

- A. Required for filing date under 37 C.F.R. § 1.53(b) (Regular) or 37 C.F.R. §1.53 (Design) Application.

☒ Enclosed is a new application.

22 Pages of specification

5 Pages of claims

12 Sheets of drawings

☒ formal

☐ informal

1 Page of abstract

- B. Other papers enclosed

- ☒ Enclosed is a copy of the prior executed Declaration and Power of Attorney for Patent Application as originally filed;
- ☒ Enclosed is a copy of the prior executed Revocation and Substitution of Power of Attorney by Assignee;
- ☒ Enclosed is a copy of the prior executed Assignment to ORATEC Interventions, Inc. with Notice of Recordation of assignment.

4. **Additional papers enclosed**

- ☒ Amendment to claims
- ☐ Cancel in this application original claim(s) _____ before calculating the filing fee. (At least one original independent claim must be retained for filing purposes).
- ☐ Add the claims shown on the attached amendment. (Claims _____ added have been numbered consecutively following the highest numbered original claims).
- ☒ Amendment to Specification.
- ☒ Amend the specification by inserting before the first line the sentence: *"This application is a continuation application of Serial No. 09/412,878 filed October 5, 1999. The entire contents of which is hereby incorporated herein by this reference."*
- ☒ A Preliminary Amendment is attached.

☐ Information Disclosure Statement (37 C.F.R. 1.98) with Form PTO-1449

☐ No fee is required.

☐ Fee regarding Information Disclosure Statement:

☐ Fee Under 37 CFR 1.17(p) \$240.00

☐ Petition Fee Under 37 CFR 1.17(i) \$130.00

Total Information Disclosure Statement Fee: \$ 0

☐ Authorization of Attorney(s) to Accept and Follow Instructions from Representative.

☐ Special Comments: _____

☐ Other: _____

5. Declaration or oath (including power of attorney)

☐ Enclosed

Executed by

☐ inventor(s)

☐ legal representative of inventor(s)

☐ Joint inventor or person showing a proprietary interest on behalf of inventor who refused to sign or cannot be reached.

☐ This is the petition required by 37 C.F.R. 1.47 and the statement required by 37 C.F.R. 1.47 is also attached.

☐ Not enclosed.

☐ Application is made by a person authorized under 37 C.F.R. 1.41(c) on behalf of *all* the above named inventor(s).

☐ A Power of Attorney by Assignee is enclosed.

☒ The Power of Attorney in the prior application is to:

Name: FLEHR HOHBACH TEST ALBRITTON & HERBERT LLP

Address: Four Embarcadero Center, Suite 3400

San Francisco, California 94111

☒ The power appears in the original papers in the prior application, a copy of the power in the prior application is enclosed.

☐ Since the power does not appear in the original papers, a copy of the power in the prior applications is enclosed.

6. Inventorship Statement

The Inventorship for all the claims in this application are:

☒ the same inventors named in the prior application.

☐ inventors fewer than all the inventors named in the prior application.

☐ please delete the following name(s) as inventor(s): _____

☐ Not the same. An explanation, including the ownership of the various claims at the time the last claimed invention was made,

☐ is submitted.

☐ will be submitted.

7. **Language**☒ English☐ Non English☐ The attached translation includes a statement that the translation is accurate. 37 C.F.R. 1.52(d).8. **Assignment**

☐ An executed assignment of the invention to: _____
☐ is attached. A separate ☐ "COVER SHEET FOR ASSIGNMENT (DOCUMENT) ACCOMPANYING NEW PATENT APPLICATION" OR ☐ FORM PTO 1595 is also attached.
☐ will follow.

☒ The prior application is assigned of record to: **ORATEC Interventions, Inc.**
 A copy of the original recorded Assignment with Notice of Recordation of Assignment Document is enclosed.

9. **Extension of time**☐ The term for response or taking action in the prior application expires on _____☐ An extension of time in the prior application is:☐ filed concurrently in the prior application.☐ has been filed on _____.

☐ Applicant hereby petitions for an extension of time in prior application serial no. _____ and encloses the fee of: **\$0.00**

Small Entity

☐ One month \$ 55.00
☐ Two months \$195.00
☐ Three months \$445.00
☐ Four months \$695.00

Large Entity

☐ One month \$110.00
☐ Two months \$390.00
☐ Three months \$890.00
☐ Four months \$1,390.00

10. **The filing fee has been calculated as shown below:**

	Number of Claims originally filed or remaining after Amendment	Minus	Basic number of claims given by the PTO	Present Extra	Small Entity Rate Fee	OR	Other than a Small Entity Rate Fee
Basic Filing Fee					\$ 355		\$710
Total Claims	19	-	20	0	x 9 = \$		x 18 = \$
Indep Claims	2	-	3	0	x 40 = \$		x 80 = \$
<input type="checkbox"/> Multiple Dependent Claim Presented and Fee not Previously Paid					+135 = \$		+270 = \$-0-
TOTAL					\$355.00		\$-0-

☒ An amendment canceling extra claims is enclosed.

- ☐ An amendment deleting multiple-dependencies is enclosed.
☐ The fee for extra claims is not being paid at this time.

Total Filing Fee:

\$ 355.00

11. **Small Entity Statement(s)**

- ☐ Enclosed is a Small Entity Affidavit.
☒ Status as a small entity was claimed in prior application, serial no. **09/412,878** filed on **October 5, 1999**, from which benefit is being claimed for this application under 35 U.S.C. § ☐ 119(e); ☒ 120; ☐ 121, or ☐ 365(c) and which status as a small entity is still proper and desired.

Total Other Fees:

\$ -0-

TOTAL FEES:

\$ 355

- ☐ Request and Certification under 35 U.S.C. 122(b)(2)(i) with attached form PTO/SB/35
- ☒ A check including the amount of the above indicated TOTAL FEES is attached.
- ☐ The Commissioner is hereby authorized to charge any underpayment of the following fees associated with this communication, including any necessary fees for extension of time, or credit any overpayment to Deposit Account No. 06-1300:
- ☐ Any filing fees under 37 CFR 1.16 including fees for the presentation of extra claims, other than large entity fees which, if paid, will be paid in response to a Notice of Missing Parts.
- ☐ Any patent application processing fees under 37 CFR 1.17.
- ☒ I hereby verify that the attached papers are a true duplicate of prior application Serial No. 09/412,878 as originally filed on October 5, 1999.
- ☒ Address all future communication to: Edward N. Bachand of Flehr Hohbach Test Albritton & Herbert LLP

Respectfully submitted,

Flehr Hohbach Test Albritton & Herbert LLP

Date

June 29, 2001
Edward N. Bachand

Reg. No. 37,085

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